

**REMARKS**

In response to the Office Action dated July 3, 2006, claims 1, 4, 10, 11 and 22 have been amended. Claims 1-24 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 11 and 22 under 35 U.S.C. § 112, second paragraph.

In response, the Applicants have amended claims 11 and 22 as suggested by the Examiner to overcome these rejections.

The Office Action rejected claims 1-3 and 6-8 under 35 U.S.C. § 102(e) as being anticipated by Kent (U.S. Patent Publication No. 2002/0040374). The Office Action rejected claims 10, 16-18, 22 and 24 under 35 U.S.C. § 102(e) as being anticipated by Castle (U.S. Patent Publication No. 2002/0077891). The Office Action rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Kent (U.S. Patent Publication No. 2002/0040374) in view of Castle (U.S. Patent Publication No. 2002/0077891). The Office Action rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Kent (U.S. Patent Publication No. 2002/0040374). The Office Action rejected claims 11-14, 19-21 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Castle (U.S. Patent Publication No. 2002/0077891).

The Applicants respectfully traverse these rejections based on the amendments to the claims and the arguments below.

With regard to claims 4-5 and 19-21 and 23, these claims were rejected under 35 U.S.C. § 103(a) in view of Castle et al. (U.S. Patent Publication No. 2002/0077891). However, according to 35 U.S.C. § 103(a) and MPEP 706, since the subject matter of Castle et al. (U.S. Patent Publication No. 2002/0077891) and the claimed invention were, at the time the invention was made, owned by and subject to an obligation of assignment to the current Assignee, Hewlett-Packard Company, and because Castle et al. was not published before the filing date of the present case, Castle et al. cannot be used as a reference under 35 U.S.C. § 102(e) to support a rejection under 35 U.S.C. §

103(a). Thus, the Applicants' submit that the rejections of claims 4-5 and 19-21 should be withdrawn and that these claims are patentable.

With regard to independent claim 1, claim 1 now includes features of claim 4 (claim 4 was rejected under 35 U.S.C. § 103(a) in view of Castle et al.) that are not disclosed by Kent, so Kent cannot anticipate the claims. Namely, claim 1 includes at least one user profile database for storing demographic information about users of said personalized media service device received from said central processing unit in response to user input on said input device and at least one database of available advertisements and corresponding advertisement bid information for providing advertisements in a predefined data format to said central processing unit for selection and printing on said printer device in response to said retrieved information from said user and said media selection from said input device.

With regard to independent claims 10 and 22, claims 10 and 22 now include features of claim 19 (claim 19 was rejected under 35 U.S.C. § 103(a) in view of Castle et al.) that are not disclosed by Castle et al., so Castle et al. cannot anticipate the claims. Namely, claims 10 and 22 now include receiving advertisement information including a number representing a number of advertisement spaces, a set of dimensions defining a size of each advertisement space, and a location for each advertisement space in the media and determining a value for each advertisement space based upon the advertisement information.

As such, since the cited references do not disclose all of the features of claims 1, 10 and 22, in light of the amendments to these claims, the rejection of claims 1, 10 and 22 should be withdrawn (MPEP 2143).

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicants in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicants' claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the


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amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly **request** the Examiner to telephone the Applicants' attorney at **(818) 885-1575**.

Please note that all mail correspondence should continue to be directed to

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